

FEDUS Declaration
for Application No:
09/896,897

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Rabbani et al.
Application No. 09/896,897
Filed: June 30, 2001
Atty Docket No. ENZ-60

OFFICE OF PETITIONS
Ms. Nancy Johnson
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MAIL STOP PETITION
Commissioner for Patents
P.O. Box 1450
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**DECLARATION OF RONALD FEDUS IN SUPPORT OF
PETITION REQUESTING THAT AN ORDER TO SHOW CAUSE BE VACATED**

Dear Commissioner:

Declarant provides the following Declaration in response to the "Order to Show Cause Why Decisions Reviving Applications Should Not Be Vacated," issued in June of 2009.

I, Ronald Fedus, declare and state as follows:

Background

1. I am a citizen of the United States residing in Queens, New York.
2. I graduated from the University of Connecticut in 1974 with a degree in psychology. I then attended the University of Guelph in Guelph, Ontario and graduated in 1978 with an undergraduate degree in biology. I next attended law school at the New England School of Law in Boston where I received a J.D. in 1983. Two years later, I received a master's level graduate degree from Northeastern University in biochemistry and molecular biology.
3. I am admitted to practice law in the states of Massachusetts and New York. I also am admitted to practice before the United States Patent & Trademark Office (USPTO). My USPTO registration number is 32.567.
4. The USPTO issued an "Order to Show Cause Why Decisions Reviving Applications Should Not Be Vacated" (Order) in a number of Enzo patent applications.

5. The Order requests an explanation for an alleged delay in filing Petitions under C.F.R. § 1.137(b) (137(b) Petition) and a showing that any delay in filing such Petitions was unintentional.

Overview of This Declaration

6. I will provide information about my duties as counsel for Enzo from the period beginning in February 1990 when I began working for Enzo up to the present.
7. I will also discuss how the prosecution of U.S. patent applications was handled by me and my general procedure for working on U.S. patent applications and responding to USPTO Actions.
8. I will address questions raised by the Petitions Attorney in the Order to Show Cause.
9. My Declaration will demonstrate that I actively prosecuted all patent matters that I was handling and that the failure to file a timely Reply and any and all delays from the time an application became abandoned to the filing of a 137(b) Petition were unintentional.

Duties from 1990 to PRESENT

10. I have been corporate and patent counsel for Enzo since February 1990.
11. My duties as corporate and patent counsel for Enzo have included prosecution of U.S. patent application families and foreign patent applications based on the U.S. patent application families, patent litigation, copyright and trademark matters, general and non-patent litigation, supply and distribution negotiations and agreements, real estate matters including office leases for blood-drawing stations, contracts, and other corporate business matters.
12. During the relevant time frames for the OSC, my patent docket included a patent prosecution docket numbering about 50 U.S. patent application families and the foreign counterparts of these U.S. patent application families. A patent application family will typically contain divisional applications in addition to continuation applications and continuation-in-part applications.

13. The numerous litigation matters in which I was involved were complicated and protracted.

14. Between early 1991 and 1993, as best as I recall, Enzo employed two patent attorneys (Elaine Brenner being the other one), and two paralegals, one of who performed primarily patent docketing. Between 1993 and 2003, I was the sole patent attorney at Enzo, except for a brief period around 2000 when there was one other patent attorney. A paralegal assisted me in patent matters beginning in 1994 until around 2004. From 2003 to at least 2006, Enzo employed two patent attorneys, including me.

Overview of Cases and Patent Matters from 1990 to 2006

15. From 1990 to the present, I have worked on a large number of complicated litigations for Enzo. *See* ¶ 11.

16. Some exemplary litigations are shown in tabular form hereinbelow. *See* Table 1.

TABLE 1: Exemplary Litigations

Litigation between Enzo and:	1991	1992	1993	1994	1995	1996	1997	1998	1999	2000	2001	2002	2003	2004	2005	2006
J&J and Ortho																
Institute Pasteur																
Calgene																
Gen-Probe																
Digene																
Amersham																
Affymetrix																
Roche Diagnostics																
Appera																

17. Between 1991 and 2006, I have participated in at least one, and as many as six or more, separate litigations for Enzo during any one year. On several occasions, I have also been deposed in these matters.

18. During this same time period, I was involved in handling a number of European and Japanese oppositions of Enzo patent applications for Enzo.

19. Table 2 lists oppositions in tabular form during this time period. *See* Table 2.

TABLE 2: Exemplary Significant Oppositions

EP/JP Opp'n	1994	1995	1996	1997	1998	1999	2000	2001	2002	2003	2004	2005
EP0 140 308												
EP0 117 440												
EP0 285 057												
JP 2 651 442												
EP0 128 322												
EP0 286 898												
JP 2 825 090												
EP0 212 670												
EP0 231 495												
EP0 330 221												

20. As shown in Table 2, between 1994 and 2005, I was involved in at least one opposition proceeding, and as many as four or more proceedings, during any one year.

21. Between 1991 and 2006, I have handled a number of supply, distribution and licensing negotiations for Enzo. Table 3 lists some of these licensing and distribution agreements that I have handled or in which I have been involved. See Table 3.

TABLE 3: Exemplary Licensing Agreements

Company	Agreement	Exec Date
Sigma Chemical	Distributorship Agr	September 10, 1992
Corange	Distributorship Agr	April 25, 1994
Amersham Int'l plc	Confidentiality & Non-Use Agr	May 20, 1994
Amersham Int'l plc	Distributorship Agr	February 1995
Sigma Chemical	Distributorship Agr	January 5, 1996
Li-Cor, Inc.	Confidentiality & Non-Use Agr	February 26, 1997
Boehringer Mannheim GmbH	Mutual Confidentiality Agr	May 9, 1997
Amersham Int'l plc	Confidentiality & Non-Use Agr	June 12, 1997
Boehringer Mannheim GmbH	Agr (Dideoynucleotides) & Due Diligence	July 11, 1997
University of California (UCSF)	Clinical Study Agr	October 7, 1997
Li-Cor, Inc.	Distributorship Agr	October 20, 1997
Japan Tobacco	License Agr	January 14, 1998
Affymetrix	Distributorship	April 24, 1998
NYN Life Science Products, Inc.	Distributor & Settlement Agr	January 1, 1999
UCSF	Amendment No. 1	February 2, 1999
Gene Logic, Inc.	Limited Use Agr	February 25, 1999
Affymetrix	Confidentiality Agr	August 15, 2000
Gene Logic, Inc.	Confidentiality & Non-Use Agr	March 20, 2001
Nycomed Amersham plc	Amendatory Agr	July 16, 2001
Gene Logic, Inc.	Letter Agr	September 7, 2001
Wyeth Pharmaceuticals, Inc.	Conf'l Disclosure & Non-Use Agr	November 4, 2002
BASF Plant Science GmbH	Nondisclosure Agr	December 9, 2002
Affymetrix	Amend't to Distributorship Agr	August 28, 2003
Affymetrix	Amend't to Distributorship Agr	September 23, 2003
SmithKline Beecham Corp	Comm'l Field of Use Program	June 4, 2004
UCSF	Clinical Study Agr	January 18, 2005
Lumora, Ltd	Confidentiality & Non-Use Agr	March 2, 2005
Gen-Probe	Purchase & Tigris Loan Agr	Sept 29, 2005
Sigma Chemical/Yale	Settlement Agr & Release	September 6, 2006

Docketing from 1990 to Present

22. The Order requests an explanation of the docketing system used by Enzo and how reply periods were managed upon receipt of an Office Action. *See* Order, 9. Also, the Order requests an explanation of how the one-year date from abandonment was docketed. *Id.*
23. A patent docket was maintained between early 1990 and the present for responding to patent matters.
24. In 1990, docketing was handled at Enzo by Ms. Louise Finnerty, and later by Ms. Christine Richards with direction from Ms. Elaine Brenner, who was a patent attorney.
25. In early 1990, Ms. Finnerty and/or Ms. Brenner would orally inform me of when docketed matters were due. I believe Ms. Finnerty utilized a docket sheet to track matters.
26. Ms. Finnerty left Enzo in 1990, and Ms. Richards left about one or two years later.
27. Ms. Brenner then maintained Enzo's docketing sheet alone or with clerical help. In 1992, Ms. Brenner left the employ of Enzo.
28. By 1993, I was Enzo's sole attorney.
29. In the early to mid-1990s, when my secretary opened a USPTO Action, she would stamp the receipt date on the Action. After the Office Action was stamped, she would place it on a table for later docketing. The docketing was done mostly by the secretary, though I recall instances where, in the absence of my secretary, or during periods when my secretary was falling behind with her work, I wrote or stamped the date of receipt of an Office action and entered the due date for Reply on my desk calendar.
30. From early 1990 to some time in 1994, as best as I recall, I kept track of deadlines by making a notation on my desk calendar and keeping the relevant application on my desk until after the Reply was filed. I kept a loose note on top of each file to remind myself that a reply was due.
31. During 1993, I was handling most of the prosecution related work for Enzo. I can no longer recall the names of the various secretaries I had during the period from 1994 to 1996 and Enzo's personnel records no longer include information going back to those years. In any event,

as best as I recall, handling of Office actions would have been similar to the one described in paragraph 29 above.

32. Beginning some time in 1997, Ms. Lisa Curtin, a paralegal at Enzo, began to docket deadlines for Enzo's files. She utilized a Microsoft word document with the built-in table function to create a table listing various due dates for applications. The table did not automatically calculate due dates for applications, nor did it reset deadlines which had passed or were in the extension period.

33. Enzo moved its corporate offices and research facilities several times. Enzo's corporate offices have been moved three times during my employment, most recently in June 1996. Enzo's research and clinical facilities have also been moved three times. Sometime around June of 1997 after Enzo moved its corporate offices to its present location in New York City, Ms. Curtin created a Microsoft Word table document in order to serve as an electronic calendar for keeping track of patent prosecution matters and which table could be used as a docketing tool.

34. Ms. Curtin used a Microsoft Word table as a docketing tool from which I extracted due dates to place on my desk calendar.

35. Ms. Curtin calculated the due dates based on mailing dates of Office Actions and provided a periodic (usually monthly) list that included deadlines that she entered on the list. The deadlines she entered were monthly anniversary dates for Replies until the maximum statutory period for reply. I did not find her monthly reminder lists particularly helpful because the due dates, once calculated, were generally not removed even though a Reply may already have been filed. These due dates were dropped only after expiration of the maximum statutory period for reply.

36. In situations where an application became inadvertently abandoned, I believe that revival deadlines were docketed once we became aware of abandonment, which was mostly at the time following receipt of a Notice of Abandonment.

37. Docket entries such as due dates, once calculated, were not removed after a Reply was filed but were removed or updated, if at all, only after receipt of an Office Action. As a result, the docket did not always reflect the actual status of an application.

38. It was necessary to check the application file when the patent docket did not indicate a reply was filed and/or was due.

39. Because patent docketing was manually done, there were times when due dates were missed because I was not apprised that a deadline was imminent.
40. It was my general practice to monitor pending applications, but nonetheless, a small percentage of my active prosecution matters inadvertently became abandoned.
41. Once I was alerted to receipt of an Office Action, generally by having the relevant file and Office Action placed on my desk, I placed a loose note (such as a post-it note) on the file to alert me to the deadline for filing a Reply. We were very cramped for space at the time, and did not have a separate filing area for the application files; many files were stored in cabinets or boxes. Due to lack of space, it was difficult, at times, to find a file among the boxes on top of boxes. This also meant that it was difficult, at times, to locate files to ascertain whether a Reply was still due, or if it had already been filed. Keeping the file on my desk was my way of ensuring that the relevant file would not be misplaced before I had an opportunity to prepare a Reply.
42. I could not usually tell from the docket report or any other part of our system whether a given application was pending or abandoned. We usually became aware of abandonment of an application either by way of a telephone call from the Examiner asking if we had filed a reply, or upon our receipt of a Notice of Abandonment mailed from the USPTO.
43. When a Notice of Abandonment was received, Ms. Curtin would docket for revival of the application at monthly intervals up until the one-year anniversary date from the date of abandonment. The entries included a caution that the last date for revival was the one-year anniversary date. Due to difficulties I encountered periodically in preparing a timely Reply or on occasion, preparing a Reply shortly after I learned of abandonment of an application, I found these monthly reminders helpful to ensure prompt filing of the 137(b) Petition and the Reply.
44. The abandonment of an application was not always brought to my attention in a timely fashion. This, coupled with the fact that, at times, it took several weeks and sometimes months to complete a Reply to the Office Action, caused delays in completing the Reply, which was a necessary component of the 137(b) Petition filing. I recall a few instances where I was alerted to the fact that we were approaching the one-year anniversary from the date of abandonment and I had still not succeeded in completing a Reply in spite of my diligent efforts. In those instances, I filed a continuation application as the Reply because of the realization that I would not be able to complete a Reply in a prompt manner.

45. The one-year revival dates were used as a cautionary notice to ensure that a 137(b) Petition was filed no later than the one-year anniversary. However, the one-year date was not used for the purpose of delaying the filing of the 137(b) Petition until the one-year anniversary, as evidenced by the monthly reminders entered on the docket sheets. It was my general practice to work on the reply and the 137(b) Petition on a continuing basis from the time I became aware of the abandonment until the filing of the 137(b) Petition, in addition to all the other work which I was handling at Enzo.

46. Looking back on events that took place at that time, it is now apparent that the docket system in place was not sufficiently sophisticated to ensure that deadlines were not missed. However, given the shortage of staffing and the "overworked" conditions under which we operated due to financial difficulties, we were barely able to meet deadlines, let alone try to find ways to improve our existing docketing system.

47. When attorney Natalie Bogdanos joined Enzo some time in April 2003, she and a secretary, Monique Sellers, took over prosecution related docketing functions from Ms. Curtin. I believe that the two of them followed a similar docketing system to the one used by Ms. Curtin.

48. Some time in 2005, as best as I recall, Ms. Liu assumed docketing responsibilities. Ms. Liu created her own Microsoft Outlook calendar docketing system where each month contained the month's cases due, the deadline date and the assigned attorney.

49. Later, in 2007, Ms. Liu began to provide a Master Docket on one page and formatted in Microsoft Excel. The Master Docket lists the cases, initial deadline, final deadline and assigned attorney.

50. In 2007, I asked Ms. Liu to mark completed entries by placing an electronically generated check-mark next to the completed entry. Before implementing the electronic check-mark, I was verbally informing Ms. Liu of completed PTO filings. Now I inform her by email.

Attempts to Locate Chronologies of Prosecution Matters

51. During prosecution of Enzo matters before the USPTO, it was my regular practice to maintain a chronology of activity related to the application.

52. Many of the records pertaining to the applications in issue have been lost or disposed of because of the passage of time (as long as 17 years), the moving of offices, and the lack of storage space and a central server. In addition, at least three catastrophic computer malfunctions destroyed Enzo's records pertaining to patent prosecution matters.

53. Around March of 2000, a computer containing documents related to Enzo's patent prosecutions suffered a permanent hardware failure, resulting in the loss of all records. Attempts were made to recover these records -- first by Enzo's IT department and then by a commercial computer document recovery service. *See* Exhibit of Invoice from "Drive Savers." Drive Savers was unable to recover my records because the data on my hard drive was corrupted and not useable.

54. To my knowledge, a computer belonging to Ms. Lisa Curtin malfunctioned in 2003. This resulted in the loss of the patent docket, although some of the docket records relevant to the OSC were found on a computer when we investigated matters after receiving the OSC. The Exhibits attached to this Petition which relate to docket entries were printed from that computer.

55. In 2008, as a result of Enzo's receipt of the initial Order to Show Cause why a number of granted Petitions to Revive should not be vacated, I attempted to locate hard copies of my chronologies and other documents related to the prosecution of these applications. These records described my activities in prosecuting Enzo applications, and they further demonstrated my practice of actively prosecuting patent applications.

56. I have searched Enzo's current corporate offices at 527 Madison Ave., New York, New York for my chronologies, but was unable to locate any documents related to the prosecution matters in issue. I believe that the several changes in locations made by Enzo's corporate offices and research facilities since the early 1990s have contributed significantly to my inability to locate documents.

57. On July 10, 2008, Ms. Curtin and I traveled to storage facilities in Farmingdale, New York, to search for my chronologies. We visited the "tower" storage facilities (an on-site building located in the parking lot at 60 Executive Blvd.). We also searched Westy's storage facilities (across from Enzo's offices), and brought several boxes of materials to Mr. Gene Rzuicldo of Hunton & Williams, LLP at 200 Park Avenue, 53rd Floor, New York, NY 10166. These boxes did not contain, however, my chronologies of the patent prosecutions in issue, which could not be found.

58. On August 27, 2008, I traveled again to Farmingdale to visit the tower and Westy's in a further attempt to locate any materials, documents, and records related to Enzo's patent docket. I also interviewed several individuals in Accounting, Personnel, and Finance at Enzo, to ascertain the possible locations of any of these records.

59. On September 2, 2008, Ms. Curtin and I again went to Farmingdale to visit the tower and Westy's in a further attempt to search for any materials in the tower storage facilities and in an additional storage room at Westy's.

60. On September 10, 2008, I traveled to Farmingdale with Ms. Curtin to make another effort to search for documents. We again searched the tower storage facilities.

61. To date, I have been unable to find any of these records.

62. As to matters internal to Enzo, e.g. matters involving only Enzo inventors, it was my practice to communicate in person, by phone, or by internal memo. The memos, chronologies, and other documentation for these matters were not found due to computer malfunctions and the amount of time between when these applications were being prosecuted and when the Show Cause order was issued by the USPTO.

***Time-frame when Specific Applications of the Order became
Abandoned and General Prosecution Practice***

63. It has always been my general practice to thoroughly and actively prosecute U.S. patent applications.

64. In most, if not the vast majority, of Enzo patent prosecution cases, I responded in a timely manner to Office Actions.

65. Where an application became inadvertently abandoned for failure to respond to an Office Action, USPTO rules required the submission of a reply to the outstanding Office Action in addition to the 137(b) Petition.

66. In responding to Office Actions, it was necessary for me to review the file history, patents and publications, the specification and the claims. At times, a Reply required the filing of one or more Declarations. In preparing the Office Action reply or Declaration, it was often necessary for me to consult with inventors, experts, and Enzo personnel.

67. It was my general practice to respond fully to an Office Action. In some cases, where additional information was required, a complete Office Action reply that addressed all grounds of rejection could not be submitted for filing with the 137(b) Petition. Therefore, I filed a continuation in order to provide a reply with the 137(b) Petition.

68. In preparing replies, I tried to actively prosecute matters by addressing each of the issues raised by the Office Actions. The necessary preparations for responding to multiple matters required a tremendous effort, especially in view of ongoing litigations and other patent and non-patent matters. These efforts were not an attempt to forestall prosecution of any application.

69. In contrast to the implications of the Show Cause Order, there could have been no motive or incentive to seek delay. In fact, there was a strong disincentive for applications filed beginning June 8, 1995 (post-GATT). These post-GATT applications have a patent term generally fixed at twenty years from issuance. A delay in prosecution would result in a shorter term of effective patent protection and would have been contrary to Enzo's goals.

Responses to Specific Questions in the Show Cause Order

70. The Order has requested a statement that the cause of delay between the date of abandonment in the matters listed in the Show Cause Order and the date of filing a grantable 137(b) Petition was not deliberate. *See* Order, 9-10.

71. I note that §1.137(b) has been revised at least twice since 1991. These amendments changed the legal standard for filing a §137(b) Petition. Under the broadest provision, now in effect, I understand that an applicant is required to make "[a] statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional."

72. I re-state that in each application listed in the Order, the entire delay in filing the required reply from the due date for the reply until the filing of a grantable Petition pursuant to this paragraph was unintentional.

73. I also re-state that the abandonments of the applications in issue were also unintentional.

74. The Order also specifically requests that the cause of delay between the date of abandonment and the date of filing a grantable Petition under 37 C.F.R. § 1.137(b) be explained. *See* Order, 9-10. Additionally, the Order also requests that the cause of delay between the date

of notification and the date of filing a grantable Petition under 37 C.F.R. § 1.137(b) be explained. *See* Order, 9-10.

75. I note that the time periods referred to in ¶ 74 overlap. I will explain why, to my knowledge, there was a delay in filing a 137(b) Petition between the date of abandonment and the Notice of Abandonment. I will also explain why there was a delay between receipt of the Notice of Abandonment and the date of filing a 137(b) Petition.

76. I will also address how these delays were unintentional. *See* Order, 9-10 (asking respondent to state "how these delays were 'unintentional.'").

77. The Order also requests a showing as to the cause of delay in discovering the abandoned status of various applications (if there was such a delay in discovery) despite the "exercise of due care or diligence on the part of [t]he applicant." *See* Order 9-10. The Order requests an explanation as to why certain revival petitions were filed near the one-year period after abandonment. *See* Order, 13.

78. Finally, the Order requests an explanation of how co-pendency was verified when electing to file a continuing application. *See* Order, 10. I declare that as a general practice, I amended specifications to reflect proper copendency with related applications.

79. Copendency was verified by examination of the application records to determine the status of an application prior to the filing of a continuation.

80. As noted above at ¶52 *et seq.*, my detailed chronologies and Linzo patent dockets for most applications cannot be located despite the efforts described above (¶56 *et seq.*). To show my general practice, I will first discuss an application for which I have been able to locate some records. This is the Application having its serial number end in '073 and is subject to the present series of Show Cause Orders.

81. My actions in prosecuting the '073 Application are illustrative of my normal routine for the preparation of a Reply to an Office Action.

82. Appended hereto as Exhibits are copies of documents related to the prosecution of the '073 Application.

The '073 Application

- 83.** This application is titled "Species of Interferon, a Process for Their Preparation and Species of Interferon Prepared Thereby," and was filed on April 10, 1992 as a continuation of the '517 application.
- 84.** On October 15, 1992, six months after filing, I telephoned the clerk of Group 1800 to inquire about the status of this application. My records indicate that the clerk stated no action had yet been taken.
- 85.** On December 17, 1992, two months later after the first inquiry and eight months after filing, I again telephoned the clerk of Group 1800 to inquire about the status of this application. My records indicate that the clerk stated no action had yet been taken.
- 86.** On March 11, 1993, three months later (eleven months after filing), I requested a third status check of the patent application.
- 87.** On March 12, 1993, I corresponded with the inventor Dr. Pravinkumar Sehgal, and I noted that "[f]it has been almost a year since we re-filed your application...[a]lthough we have been checking on its status with the clerk of group 1800 in the [USPTO] for the past four or five months, we thought it appropriate to make a formal inquiry as to its status...."
- 88.** As is apparent from the above, I inquired into the status of this pending application several times. When no USPTO Action was received, I made appropriate inquiries with the USPTO. This was my general practice.
- 89.** On March 23, 1993, an Office Action dated March 18, 1993, was received by Enzo and stamped accordingly.
- 90.** The Office Action contained substantive rejections including: lack of patentable utility (§ 101), lack of enabling disclosure (§ 112, 1st ¶), indefiniteness (§ 112, 2nd ¶), anticipation (§ 102(a) and (f)), and obviousness (§ 103).
- 91.** My records indicate that on March 23, 1993, I provided summaries of the Office Action to Drs. Rabbani and Engelhardt (Enzo officers and scientists), and the inventor, Dr. Sehgal. In my letter to Dr. Sehgal, I noted that a Rule 131 Declaration could be used to overcome the anticipation rejection over a reference cited by the PTO and that such a Declaration would need

to incorporate notebook pages evidencing reduction to practice of the invention prior to the date of the reference. I also requested meetings with Dr. Sehgal to discuss a possible Reply.

92. The commentary and suggestions of Drs. Sehgal, Rabbani and Engelhardt were necessary to prepare a complete reply to the Office Action.

93. In preparing replies to Office Actions, such as the reply in this instance, I often would have to communicate with the inventor(s) and if necessary, experts or Enzo personnel. Due to inventors' and/or officers' busy schedules, it would require some time to schedule meetings. Meetings also required preparation which included the gathering of documents, analysis of documents, and legal research. Finally, meetings also required subsequent action(s) which included follow-up meetings, the further retrieval of documents, and additional analysis and research.

94. The six month due date for a reply with all available extensions to the March 23 Office Action was September 23, 1993. I received a message on September 23, 1993, indicating the Examiner had telephoned. On September 24, 1993, I returned the telephone call to the Examiner, discovered the unintentional abandonment, and noted that I would attempt to have a reply within the following month.

95. A Notice of Abandonment was sent by the USPTO on October 4, 1993. Enzo received the Notice, which was then date-stamped October 6, 1993. Enzo also implemented a stamp on the Notice to indicate a three-month reply period, demonstrating my intent to reply promptly from the date of receipt of the Notice of Abandonment.

96. On October 12, 1993, I wrote to Dr. Sehgal and informed him that we would be assisted by another attorney, Mr. John J. Santalone (outside counsel), who would be "out of the country for the next week or so." In accordance with my request and for possible use in the Reply, Dr. Sehgal provided me with his laboratory notebooks and other documents for photocopying.

97. On October 18, 1993, a publication search was conducted at Enzo. The results revealed three patent documents. The citations for these three patents were sent to Dr. Sehgal.

98. I also corresponded with the New York Public Library Patent Depository and requested copies of the patent documents cited in the search results, which was the general practice at the time. To expedite the retrieval of these documents, I recall traveling to the New York Public

Library Patent Depository, a separate Annex facility on the West side of Manhattan, and making copies of these documents, which were stored on microfiche.

99. On October 21, 1993, copies of the retrieved patent documents were provided to Dr. Sehgal in a further letter. The letter stated my intent to send draft Declarations to Dr. Sehgal to support the replies to the Examiner's rejections.

100. On January 27, 1994, I sent a letter to the inventor regarding filing a Declaration and Reply. I stated that it is "[o]ur goal...to file a complete reply as early as possible next month (February)...." In my letter, I also sent to Dr. Sehgal a copy of a published case (*Fiers v. Sugano*). I sent this case because the prior art search uncovered a Revel EU patent document (Revel was a party to the case), and I thought it would be of interest to Dr. Sehgal.

101. In coordinating various parties who were necessary for filing a Reply, time was required to allow myself and others to review, analyze, and to comment on Office Actions, patents and publications, the specification and claims, and other related documentation. In addition to myself, many of the individuals were involved in the prosecution of more than one application. In addition to their normal duties, these other individuals also had to provide substantive information in multiple prosecutions.

102. Between January and June of 1994, I continued to prepare a Reply and a Rule 131 Declaration. I have been unable to locate my chronologies but based on my activities described above in ¶56 *et seq.*, I believe that I continued to actively engage with the inventors and Enzo personnel in order to prepare a proper and complete substantive Reply.

103. My activities between January and June of 1994 would have included telephone calls and other correspondence with Dr. Sehgal and Enzo personnel. My foundation for this belief is based on what I can recall, the records I have been able to locate, and the pattern of correspondence and active prosecution that those records demonstrate. For example, as noted above, I sent a letter on Jan 27, 1994, stating that it was my intent to "file a complete Reply as early as possible next month (February)." I also sent correspondence in June to Drs. Christine Brakel and James Donegan regarding the pending claims and Declaration. These records demonstrate I was actively pursuing the prosecution of this matter during the period between January and June of 1994. It is also my recollection that the preparation of the Reply and Declaration, which was necessary to overcome the Examiner's rejections, was particularly time-

consuming because of the technical nature of the invention, and the cited patents and publications.

104. On June 13, 1994, I sent a letter to Dr. Brakel, and requested a conference call to discuss the pending claims. I also corresponded with Dr. Brakel and Dr. Donegan regarding Dr. Sehgal's lab notebooks related to the patent application and Rule 131 Declaration.

105. On June 13, 1994, I also sent a letter to Dr. Sehgal, and reminded him of the urgency in filing a Reply. I stated:

Although we had intended to send you prior to your departure to Europe this week a draft declaration for review, it appears that with the impending deadline for petitioning the [USPTO] fast approaching, we should proceed to re-file the present application. In this way, we can thoroughly address all of the issues presented in the March 18, 1993 Office Action. The present situation has been further complicated by the absence from the country of Dr. Dean L. Engelhardt and John J. Santalone, Esq., both of whom are assisting in the prosecution of your application. As soon as both return, I will meet with them to go over some matters prior to contacting you further.

106. The 137(b) Petition, filed June 16, 1994, stated that the application was "unintentionally abandoned." This was an accurate statement as well as the entirety of what was required by way of a statement for a petition to revive based on regulations and MPEP guidelines in existence at the time. Although my activities after abandonment as explained above reflect an attempt to prepare a proper Reply during the entire period of abandonment, the language used in the Petition was the one required at the time, rather than the current required language of unintentional delay during the entire period of abandonment. Nevertheless, even with the PTO's questioning of the delay based on the current standards, I hereby state that the entire delay, from the time that a Reply was due until the filing of a grantable petition to revive, was unintentional.

107. I note that I have filed 137(b) Petitions in other cases, one of which is subject to the Show Cause Order prior to the mailing of a Notice of Abandonment. These cases include the following applications: 09/104,067; 09/561,591 (subject to Order to Show Cause) and 10/096,075.

108. The 137(b) Petition was granted on August 31, 1994.

109. In this application, there was an unintentional delay in filing a timely Reply and an unintentional delay between the date of abandonment and the filing of a 137(b) Petition. As the

above events demonstrate. I actively pursued prosecution of this matter but was unable to file a complete Reply without the necessary information and action by various individuals.

110. It was never my intention to delay prosecution of any application at any point in time. Any delay was not the result of “being too busy” or prioritizing other matters ahead of filing a Petition. The delays were beyond my control because time was needed by me to prepare a complete and substantive Reply. Time was also needed by inventors and Enzo personnel to analyze and review documents, scientific information, the specification and claims of the application, and even the Office Action.

111. In those instances where there was a delay in discovering the abandoned status of an application, the delay was the result of not receiving notification as to the abandoned status of an application, and not being otherwise aware of the abandoned status of an application.

112. In those instances where applications were revived one year from abandonment, attempts at preparing a proper Reply for inclusion in the 137(b) Petition were unintentionally delayed. As demonstrated above, I attempted to prepare a full Reply and not merely file a continuation application. However, when I was unable to prepare a full Reply because of delays beyond my control, I filed a continuation application in order to be able to complete the preparation of a proper and substantive Reply.

113. In contrast to the alleged “pattern” of abandonments and revivals suggested by the Show Cause Order, my actions in the ‘073 case and others demonstrate a pattern of diligence in preparing substantive Replies. Additionally, I managed ongoing litigations, was involved in contract negotiations and drafting, as well as other legal duties during this period of time.

114. My general practice in prosecuting a large docket of cases has been to actively prepare suitable replies that advance the prosecution of any given application. When my practice in prosecuting patent applications is viewed in its entirety, including the attendant responsibilities in properly prosecuting any one case, then a pattern of diligence emerges.

115. Although submission of the 137(b) Petition in the above Application may appear to be uncomplicated - because the proposed reply was a request for a continuation application - existing records demonstrate that the delay was not for purposes of acquiring an extension. The delay was the result of necessary preparations required to file a complete Reply to the Office Action. These necessary preparations include the preparation of at least one Declaration,

analysis of the file history and Office Action, correspondence and meetings with the inventor and other experts, the analysis of patents and publications, and the drafting of arguments. As noted above in ¶113, when I was unable to prepare a full Reply because of delays beyond my control, I filed a continuation to continue prosecution of the application and to complete the preparation of a proper and substantive Reply.

116. Documents such as those discussed above at ¶85 *et seq.* in the '073 application demonstrate that it was my practice to actively prosecute pending patent applications.

117. Although I do not have complete records of each of the applications at issue in the Orders, my actions with respect to the '073 application are representative of how I prosecuted the present application subject to the present Order.

118. As noted in my discussion of the docketing system above at ¶24 *et seq.*, Enzo utilized a manual docketing system which was not updated automatically after the filing of an Office Action Reply. Accordingly, I was not always aware that an application had gone abandoned because inspection of the docket would not indicate whether a reply had been filed. This required the manual inspection of records, which was not always achievable due to the occasional difficulty in locating files in our office, as explained above.

119. As a result, the applications at issue in the present Orders became unintentionally abandoned. Because I had no knowledge that an application was abandoned until notice to that effect was given to me, any delay during these time periods was unintentional. Likewise, I confirm that the abandonments in the present application were unintentional.

120. Furthermore, once aware of an unintentional abandonment, such as by receipt of a Notice of Abandonment, it was my practice to actively prepare a Reply on the merits that addressed all outstanding issues of the Office Action. As explained above, I actively pursued preparation of replies in the present Application.

121. The necessary review, preparation, analysis, drafting, revising, and finalizing, in addition to communications with persons relevant to the prosecution of the application such as the inventors, Enzo personnel, and/or experts, frequently required an extensive amount of time.

122. I utilized the time subsequent to being alerted to abandonment of an application to prepare a Reply and Rule 137(b) Petition. As it was my general practice, I believe I utilized the time necessary for preparation of a reply to file replies in the present application. In addition to

my own efforts to prepare a Reply, I was further prompted by periodic docket reminders to complete a Reply for filing along with the Petition to Revive.

123. Therefore, the delay from the time I became aware that the application was inadvertently abandoned to the time I filed the Rule 137(b) Petition was unintentional, as any delay was only the result of the need to prepare a proper, substantive Reply.

124. In the instance where a non-substantive Reply was filed, such as continuation filing, it was my general practice to attempt to file a substantive Reply. I only filed a non-substantive Reply when I determined that the preparation of a substantive Reply could not have been accomplished within the regulatory deadline in effect, at the time, for filing a petition under Rule 137(b). Incomplete Reply filings would not have advanced the prosecution of the application. Therefore, it was my practice to file a continuation to resume active prosecution of an application while I continued to prepare a proper, substantive Reply.

Discussion of Show Cause Order vis-à-vis the Present Application

125. With respect to the abandonment of this application, surviving Enzo records show that the Office action was properly docketed for a reply, as shown by the attachments to this Petition. Furthermore, the petition to revive was also docketed for reply with indications that the Reply had already been filed.

126. The '897 application had two instances of unintentional abandonment. With regard to the 1st instance of abandonment, Enzo docket entries are available to show how the Office action due date and due dates after the notice of abandonment were noted in the docket report. In the usual manner, the Office actions were docketed for six months on a monthly basis from the mailing date of the Office action. There was an indication that a reply was filed by the time of receipt of the Notice of Abandonment.

127. A copy of the docket report is attached, wherein the report was modified to include a header for reference purposes, i.e., "J10018 DOCKET REPORT EXHIBIT p. 1-6". Additionally, specific entries that are not relevant to the present application have been redacted and annotated with the letter designation "nn." Enzo's electronic docket records provide docket entries from October 12, 2001 to October 19, 2002. The following entries are relevant to the present application, which was assigned by Enzo docket number ENZ-60:

10/12/01 ENZ-60 – Notice of missing parts issued filing fee, oath/dec, substitute drawings and sequence listing needed

11/12/01 ENZ-60 – 1 mo. after 10/12/01 Notice of missing parts issued filing fee, oath/dec, substitute drawings and sequence listing needed

12/12/01 ENZ-60 – 2 mo. after 10/12/01 Notice of missing parts issued filing fee, oath/dec, substitute drawings and sequence listing needed

1/12/02 ENZ-60 – 3 mo. after 10/12/01 Notice of missing parts issued filing fee, oath/dec, substitute drawings and sequence listing needed

2/12/02 ENZ-60 – 4 mo. after 10/12/01 Notice of missing parts issued filing fee, oath/dec, substitute drawings and sequence listing needed

3/12/02 ENZ-60 – 5 mo. after 10/12/01 Notice of missing parts issued filing fee, oath/dec, substitute drawings and sequence listing needed

4/12/02 ENZ-60 – LAST DAY TO RESPOND TO NOTICE of missing parts issued filing fee, oath/dec, substitutedrawings and sequence listing needed

9/11/02 ENZ-60 – Assignment returned – cover sheet needs to be completed

9/19/02 ENZ-60 – Nt of abandonment issued for failure to respond to nt of missing parts (we did respond on 6/28/02!) Respond to this!

10/19/02 NZ-60 – RESPOND TO THIS! –1 MO. AFTER Nt of abandonment issued for failure to respond to nt of missing parts (we did respond on 6/28/02!) Respond to this! Note that the assignment which was included in the 6/28/02 filing was returned as cover sheet needed to be corrected.

128. The docket does not provide status entries, but it does include reminders to revive promptly.

First Abandonment with Notice of Abandonment on September 19, 2002

129. An Office Action was mailed October 12, 2001, but there is no stamp on the action to indicate receipt by Enzo. The application became inadvertently abandoned on November 13, 2001.

130. A Notice of Abandonment was mailed September 19, 2002, but there is no copy of the Notice in Enzo's file.

131. The Petition to Revive was filed on June 28, 2002, wherein I stated that the "entire delay in filing the required reply ... was unintentional". Submitted concurrently with the Petition was a Response to the Notice to File missing parts.

132. The Petition was filed on June 28, 2002, 228 days from the date of abandonment and 83 days before the notice of abandonment was mailed. The petition was granted on February 19, 2003, almost 8 months after the filing of the Petition to Revive.

Second Abandonment

133. An Office Action was mailed on March 2, 2005. There was a note placed on the Office Action stating "Last day to respond: 9/2/05".

134. A response was filed to this Action along with a request for an extension of time and the receipt by the PTO was confirmed in a telephonic interview with Examiner Joyce Tung on September 19, 2005. I was informed by Examiner Tung that the response after final had been received and would be reviewed "in the near future".

135. The application became abandoned on September 3, 2005 and the Notice of Abandonment which was mailed on November 15, 2005 stated that the reply of September 2, 2005 was not a proper reply.

136. I filed a Petition to Revive on November 29, 2005, 86 days from the date of the abandonment of the application and 14 days after the mailing of the Notice of Abandonment. Accompanying the Petition was the required response which included the submission of a Notice of Appeal.

137. The Petition was granted on February 13, 2006, about two and a half months after the

filing of the Petition to Revive.

Conclusion

138. In both instances of inadvertent abandonment, the Petition to Revive was filed well within PTO guidelines for prompt filing of a Petition to Revive. In both instances, the abandonment was inadvertent and unintentional. This is clear in the second instance where a response was filed and the receipt of the response was verified by me. It was only after receipt of the Notice of Abandonment that I realized that an acceptable Reply such as a Notice of Appeal had not been filed in response to the final rejection. I affirm that my actions in both instances were diligent and continual and there was no intentional delay in the filing of the papers needed to obtain revival of the application.

I further declare that all statements made herein are based on personal knowledge or upon information and belief and are believed to be true; and further that the statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing thereon.

SIGNED



Ronald Fedus

DATED

August 10, 2009